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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,100	04/10/2004	Giovanni Prodi	12693.0027.00US00	1720

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HOWREY LLP  
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2941 FAIRVIEW PARK DRIVE, SUITE 200  
FALLS CHURCH, VA 22042-7195

EXAMINER
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HOANG, JOHNNY H

ART UNIT	PAPER NUMBER
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3747

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/822,100

Applicant(s)

PRODI ET AL.

Examiner

Johnny H. Hoang

Art Unit

3747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/21/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Inventorship*

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### *Specification*

2. The disclosure is objected to because of the following informalities: the reference to the claims in paragraph [0010] should be deleted.

Appropriate correction is required.

### *Claim Objections*

3. Claim 1 is objected to because of the following informalities:

In claim 1, line 3; "actuators (10, 13)" should be --actuators (10, 15)--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lehner et al (US 5,765,527).

Regarding claim 1, the reference of Lehner et al discloses a method and arrangement for controlling the torque of internal combustion engine including the following subject matters: controlling the speed of a torque-controlled internal combustion engine in which the generation of the drive torque to a drive shaft is regulated by actuators which are controlled from a control value of the instantaneous torque and by a control value of the predicted torque; the method providing for the calculation of the objective value of the speed and the generation of the control value of the instantaneous torque by means of a first feedback control loop which uses as input the objective value of the speed; the method being characterized in that an objective value of the torque reserve is calculated, an objective value of the potential torque is calculated on the basis of the objective value of the torque reserve, and the control value of the predicted torque is generated by means of a second feedback control loop which uses the objective value of the potential torque as input (see Fig. 1; and col. 3, line 5 through col. 5, line 44).

Claims 2-13, and 16 are rejected as the same rejection of claim 1.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehner et al in view of Lukich et al (US 6,133,643).

The reference of Lehner et al discloses the invention as claimed except the gains of controllers, and controlling the generation of instantaneous torque is adapted directly to govern the value of the speed of engine. However, the reference of Lukich et al teaches the governor gains are determined by determining the current engine mode, selecting the appropriate gain look-up table in response to the engine mode, and responsively selecting a gain value from the look-up table in response at least one of desired and actual speed (see abstract).

It would have been an obvious to one of ordinary skill in the art at the time the invention was made to modify and/or provide the method of Lehner et al with a governor gains value, as taught by Lukich et al, so as to prevent the sudden changes in surrounding conditions, such as a brief period of sudden and heavy acceleration.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Surnilla (US 6,735,938 B2); and Kolmanovsky et al (US 6,716,137 B1).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny H. Hoang whose telephone number is (571) 272-4843. The examiner can normally be reached on Monday - Thursday (7:00Am-5: 30Pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on (571) 272-4856.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHH  
July 20, 2005

Johnny H. Hoang  
Examiner  
Art Unit 3747

  
**Tony M. Argenbright**  
**Primary Examiner**  
**Art Unit 3747**